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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,823	06/12/2001	Craig W. Barnett	23419-003-408	6075
29315	7590	07/12/2004	EXAMINER	
MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC 12010 SUNSET HILLS ROAD SUITE 900 RESTON, VA 20190			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/879,823	Applicant(s) BARNETT ET AL	
	Examiner Arthur Duran	Art Unit 3622	<i>NW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/8/04, 4/5/04</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS 4/19/04</u> |

DETAILED ACTION

1. Claims 47-62 have been examined.

Interference

2. Applicant's provocation of an Interference with Patent 6,075,971 has been noted.

However, claims 47-62 are rejected as stated below. Therefore, an Interference has not been initiated.

Response to Amendment

3. The Amendment filed on 4/5/04 is sufficient to overcome the prior rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 47, 52, 57, and 61 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 47, 52, 57, 62 disclose "wherein each coupon may be used a predetermined number of times," and "monitoring redemption of the one or more coupons such that each coupon may

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be used a predetermined number of times”.

The Applicant states several references in the specification as disclosing the terms of this claim.

Applicant has disclosed independent claims which are broader in scope than the specification. The specification states that a coupon can be used only once. However, the phrase ‘predetermined number of times’ in the independent claims is open to the coupon being redeemed more than once. A predetermined number of times can be read as broader than only once. For example, a predetermined number of times can be 5 or 10 or 20, etc. However, only once, as stated in Applicant’s specification, can only be read as limited to one. Therefore, the independent claims are broader than the specification and, therefore, are only supported by the specification in the case when the predetermined number of times in the claims is understood to be one.

Additionally, all dependent claims on independent claims 47, 52, and 57 are rejected as being dependent upon said claims.

Claims 47, 52, 57, 61, 62 disclose a ‘preferences of the users stored in the respective user’s devices’. However, the specification does not disclose any preferences or profile stored on the user’s devices. For example, the Barnett patent 6,321,208, which has the same specification as this application, demonstrates with the citation (col 12, lines 25-50) how the user’s preferences are not stored on the user’s device. Rather, user preference information is determined and stored at a central location.

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Additionally, the Applicant's citations in the Amendment dated 4/5/04 attempting to show support for this feature do not demonstrate that this feature is supported by the specification.

Additionally, all dependent claims on independent claims 47, 52, and 57 are rejected as being dependent upon said claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 47-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Kohorn (5,227,874).

Claim 47, 52, 57, 61, 62: Von Kohorn discloses a method, apparatus, medium comprising:

determining a target audience of one or more users of devices coupled to a network, wherein the target audience is determined based on one or more preferences of the users stored in the respective users' devices, and

providing a coupon to the target audience determined, wherein each coupon may be used a predetermined number of times, wherein providing a coupon to the target audience further comprises:

determining a subset of users of the network based on a preference profile;

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delivering one or more coupons to the subset of users' (col 2, lines 20-25; col 2, lines 4-14; col 104, line 65-col 105, line 31; col 105, line 65-col 106, line 10), and

monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times (col 17, lines 10-31; col 20, lines 38-44; col 86, lines 10-25; col 87, lines 59-65).

Von Kohorn further discloses monitoring redemption of the one or more coupons to prevent fraud (col 17, lines 10-25; col 95, lines 19-41; col 16, lines 55-59).

Additionally, the Microsoft Press Computer Dictionary Third Edition defines 'personal computer' as,

"A computer designed for use by one person at a time. Personal computers do not need to share the processing, disk, and printer resources of another computer."

Von Kohorn discloses the utilization of a personal computer by the users (Fig. 26; col 75, lines 31-49; col 76, lines 20-33; col 14, lines 20-25).

Von Kohorn further discloses the utilization of a personal computer by the users (Fig. 26; col 75, lines 31-49; col 76, lines 20-33).

Claim 48, 53, 58: Von Kohorn discloses the method of claim 47, wherein determining a target audience further comprises:

monitoring network usage by the users (col 105, line 65-col 106, line 10; Fig. 1);

determining a preference profile for respective users, wherein the preference profile is based on network usage by the respective users; and selecting a subset of users of the network based on the preference profile (col 104, line 65-col 105, line 31).

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Claim 49, 54, 59: Von Kohorn discloses the method of claim 47, wherein determining a target audience further comprises:

determining a preference profile for respective users, wherein the preference profile is based on revealed preferences of the respective users; and

selecting a subset of users of the network based on the preference profile (col 104, line 65-col 105, line 31; col 105, line 65-col 106, line 10).

Claim 50, 55, 60: Von Kohorn discloses the method of claim 47, wherein monitoring redemption of the one or more coupons further comprises:

maintaining a coupon database that stores information related to coupons that have been distributed (col 2, lines 20-28); and

checking the coupon database to determine whether a particular coupon is valid (col 86, lines 10-25; col 87, lines 59-65; col 17, lines 10-31; col 20, lines 38-44).

Claim 51, 56: Von Kohorn discloses the method of claim 47, wherein monitoring redemption the one or more coupons further comprises serializing the coupons (col 2, lines 20-25) such that each coupon may be redeemed once (col 17, lines 10-31; col 20, lines 38-44; col 86, lines 10-25; col 87, lines 59-65).

Response to Arguments

6. Applicant's arguments with respect to claims 47-62 have been considered but are moot on grounds of the new rejection above.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art.

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Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Saigh (5,734,823) discloses the utilization of coupons, networks, and the Internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran
Patent Examiner
7/1/04